

REMARKS**I. General**

Claims 1-28 are pending in the application, and all are rejected by the Office Action mailed September 26, 2005. Claims 2, 3, 5-7, 9-13, 17, 22, 24, 25, 27, and 28 are amended by this response. The issues in the current Office Action are:

- Claim 11 is objected to.
- Claim 12 is rejected under 35 U.S.C. §112, first paragraph.
- Claims 2, 3, 5-7, 9, 10, 13, 17, 22, 24, 25, 27, and 28 are rejected under 35 U.S.C. §112, second paragraph.
- Claims 1, 5, 6, 10, 11, 13, 16, 21-23, 25, 27, and 28 are rejected under 35 U.S.C. §102(b) over US Patent Application Publication 2001/0042170 (hereinafter, *Belknap*).
- Claims 2-4, 7, 8, 12, 17-19, 24, and 26 are rejected under 35 U.S.C. §103(a) over *Belknap* in further view of US Patent Application Publication 2002/0152874 (hereinafter, *Vilcauskas*).
- Claims 9 and 14 are rejected under 35 U.S.C. §103(a) over *Belknap* in further view of US Patent Application Publication 2002/010877 (hereinafter, *Whiting*).
- Claim 15 is rejected under 35 U.S.C. §103(a) over *Belknap* in further view of *Vilcauskas* in further view of US Patent Application Publication 2002/0002413 (hereinafter, *Tokue*).
- Claim 20 is rejected under 35 U.S.C. §103(a) over *Belknap* in further view of *Vilcauskas* in further view of US 6,925,342 (hereinafter, *Hars*).

Applicant hereby traverses the rejections and requests reconsideration and withdrawal in light of the remarks contained herein.

II. Amendments to the Claims

Claim 2 is amended to recite, in part, “ones of said plurality of files.” Such amendment is not in response to any art. Rather, such amendment is merely cosmetic and does not add new matter, nor does it narrow the scope of the claim.

Claim 3 is amended to recite, in part, “at least one of said plurality of files.” Such amendment is not in response to any art. Rather, such amendment is merely cosmetic and does not add new matter, nor does it narrow the scope of the claim.

Claim 5 is amended to recite, in part, “the files of said list.” Such amendment is not in response to any art. Rather, such amendment is merely cosmetic and does not add new matter, nor does it narrow the scope of the claim.

Claim 6 is amended to recite, in part, “each file of said list” and to delete “sufficient.” Such amendment is not in response to any art. Rather, such amendment is merely cosmetic and does not add new matter, nor does it narrow the scope of the claim.

Claim 7 is amended to recite, in part, “the files of said list.” Such amendment is not in response to any art. Rather, such amendment is merely cosmetic and does not add new matter, nor does it narrow the scope of the claim.

Claim 9 is amended to recite, in part, “on a storage medium at said backup/restoration service.” Such amendment is not in response to any art and does not add new matter.

Claim 10 is amended to recite, in part, “said files of said list.” Such amendment is not in response to any art. Rather, such amendment is merely cosmetic and does not add new matter, nor does it narrow the scope of the claim.

Claim 11 is amended to recite, in part, “a file server.” Such amendment merely fixes a typographical error and does not add new matter. It is not in response to any art, nor does it narrow the scope of the claim.

Claim 12 is amended to delete the text after “said compressed audio encoding format.” Such amendment does not add new matter. It is not in response to any art, nor does it narrow the scope of the claim.

Claim 13 is amended to recite, in part, “said files of said list” and to replace “compatible” with “useable.” Such amendment is not in response to any art. Rather, such amendment is merely cosmetic and does not add new matter, nor does it narrow the scope of the claim.

Claim 17 is amended to recite, in part, “said plurality of files.” Such amendment is not in response to any art. Rather, such amendment is merely cosmetic and does not add new matter, nor does it narrow the scope of the claim.

Claim 22 is amended to delete “sufficient.” Such amendment is not in response to any art. Rather, such amendment is merely cosmetic and does not add new matter, nor does it narrow the scope of the claim.

Claim 24 is amended to recite, in part, “said files of said list.” Such amendment is not in response to any art. Rather, such amendment is merely cosmetic and does not add new matter, nor does it narrow the scope of the claim.

Claim 25 is amended to recite, in part, “said files of said list.” Such amendment is not in response to any art. Rather, such amendment is merely cosmetic and does not add new matter, nor does it narrow the scope of the claim.

Claim 27 is amended to recite, in part, “the files of said list.” Such amendment is not in response to any art. Rather, such amendment is merely cosmetic and does not add new matter, nor does it narrow the scope of the claim.

Claim 28 is amended to recite, in part, “each file of said list” and to delete “sufficient.” Such amendment is not in response to any art. Rather, such amendment is merely cosmetic and does not add new matter, nor does it narrow the scope of the claim.

III. Claim Objections

Claim 11 is objected to for use of the term, “sever.” Applicant has amended claim 11 to replace that term with “server.” Accordingly, withdrawal of the objection to claim 11 is respectfully requested.

IV. Claim Rejections Under 35 U.S.C. §112, First Paragraph

Claim 12 is rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Without conceding that the feature lacks enablement, Applicant has amended claim 12 to delete the text after “said compressed audio encoding format” in order to advance prosecution. Accordingly, withdrawal of the 35 U.S.C. §112, first paragraph rejection of claim 12 is respectfully requested.

V. Claim Rejections Under 35 U.S.C. §112, Second Paragraph

Claims 2, 3, 5-7, 9, 10, 13, 17, 22, 24, 25, 27, and 28 are rejected under 35 U.S.C. §112, second paragraph, for indefiniteness. Without conceding that those claims are indefinite, Applicant has made various cosmetic amendments to each of the claims in order to advance prosecution. It is believed that those claims are definite. Accordingly, withdrawal of the 35 U.S.C. §112, second paragraph rejection of claims 2, 3, 5-7, 9, 10, 13, 17, 22, 24, 25, 27, and 28 is respectfully requested.

VI. Claim Rejections Under 35 U.S.C. §102

Claims 1, 5, 6, 10, 11, 13, 16, 21-23, 25, 27, and 28 are rejected under 35 U.S.C. §102(b) over *Belknap*. Applicant traverses the rejection.

To anticipate a claim under 35 U.S.C. § 102, a reference must teach every element of the claim, see M.P.E.P. § 2131. Moreover, in order for an applied reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he identical invention must be

shown in as complete detail as is contained in the . . . claim,” see M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). As discussed further below, these requirements are not satisfied by the 35 U.S.C. § 102 rejection because *Belknap* does not teach every element of the claims.

In dependent claim 1 recites, in part, “transmitting a list of the files along with the associated ownership property to a backup/restoration service.” *Belknap* does not teach this feature of claim 1. The Office Action points to paragraphs [0026], [0028], and [0029] to teach the feature. It appears that the Office Action equates library catalog 212 of *Belknap* with the claimed list of files. However, it should be noted that *Belknap* does not teach that the library catalog 212 is transmitted to anything, much less to a backup/restoration service.

While *Belknap* teaches that library server 210 “checks” library catalog 212 for names, passwords, and privileges, this does not teach the above-quoted feature of claim 1 because *Belknap* does not teach that a list of files is transmitted to library server 210. It should be noted that the checking performed by library server 210 is not enough to teach transmitting a list of files for at least two reasons. First, *Belknap* does not teach that the checking involves transmitting a list of files. Second, such checking may, for example, include as little as receiving a “yes or no” answer in response to a query rather than transmitting a list of files. Further, *Belknap* does not teach that library server 210 is a restoration/backup service. Therefore, the above-mentioned feature of claim 1 is not taught by *Belknap*.

Claim 11 recites, in part, “a communications link for transmitting a list of the files to a remote location,” and “a file server located at the remote location...operable to receive and store the list of files.” *Belknap* does not teach the above-recited features of claim 11 because *Belknap* does not teach transmitting or receiving a list of files.

First, *Belknap* does not teach the claimed transmitting a list of the files. The Office Action cites library server 210, media object server 220, media server 130, and media archive 140 of *Belknap* as teaching the claimed file server. While *Belknap* teaches that library server 210 “checks” library catalog 212 for names, passwords, and privileges, this does not teach the above-quoted feature of claim 11 because *Belknap* does not teach that a list of files is transmitted to library server 210. It should be noted that the checking performed by library

server 210 is not enough to teach transmitting a list of files for at least two reasons. First, *Belknap* does not teach that the checking involves transmitting a list of files. Second, such checking may, for example, include as little as receiving a “yes or no” answer in response to a query rather than transmitting a list of files.

Second, *Belknap* does not teach the claimed receiving the list of files because not one of the *Belknap* components cited as being the claimed file server receives a list of the files. Accordingly, the *Belknap* does not teach the above-recited feature of claim 11.

Claim 16 recites, in part, “computer readable program code means for causing a computer to transmit a list of the files to a backup/restoration service.” *Belknap* does not teach this feature of claim 16. The Office Action points to paragraphs [0026], [0028], and [0029] to teach the feature. It appears that the Office Action equates library catalog 212 of *Belknap* with the claimed list of files. However, it should be noted that *Belknap* does not teach that the library catalog 212 is transmitted to anything, much less to a backup/restoration service.

While *Belknap* teaches that library server 210 “checks” library catalog 212 for names, passwords, and privileges, this does not teach the above-quoted feature of claim 16 because *Belknap* does not teach that a list of files is transmitted to library server 210. The checking performed by library server 210 is not enough to teach transmitting a list of files for at least two reasons. First, *Belknap* does not teach that the checking involves transmitting a list of files. Second, such checking may, for example, include as little as receiving a “yes or no” answer in response to a query rather than transmitting a list of files. Further, *Belknap* does not teach that library server 210 is a restoration/backup service. Therefore, the above-mentioned feature of claim 16 is not taught by *Belknap*.

Claim 23 recites, in part, “receiving a list of files stored at a remote location.” *Belknap* does not teach this feature of claim 16. The Office Action points to paragraphs [0026] and [0028] to teach the feature. It appears that the Office Action equates library catalog 212 of *Belknap* with the claimed list of files. However, it should be noted that *Belknap* does not teach that the library catalog 212 is received.

While *Belknap* teaches that library server 210 “checks” library catalog 212 for names, passwords, and privileges, this does not teach the above-quoted feature of claim 16 because *Belknap* does not teach that a list of files is received by the library server. The checking performed by library server 210 is not enough to teach receiving a list of files for at least two reasons. First, *Belknap* does not teach that the checking involves receiving a list of files. Second, such checking may, for example, include as little as receiving a “yes or no” answer in response to a query rather than receiving a list of files. Therefore, the above-mentioned feature of claim 16 is not taught by *Belknap*.

Dependent claims 5, 6, 10, 13, 21, 22, 25, 27, and 28 each depend from respective independent claims 1, 11, 16, and 23 and, thus, inherit all of the limitations of their respective independent claims. Thus, *Belknap* does not teach all claim limitations of claims 5, 6, 10, 13, 21, 22, 25, 27, and 28. It is respectfully submitted that dependent claims 5, 6, 10, 13, 21, 22, 25, 27, and 28 are allowable at least because of their dependence from their respective base claims for the reasons discussed above. Accordingly, withdrawal of the 35 U.S.C. §102(b) rejection of claims 1, 5, 6, 10, 11, 13, 16, 21-23, 25, 27, and 28 is respectfully requested.

VII. Claim Rejections Under 35 U.S.C. §103

A. Claims 2-4, 7, 8, 12, 17-19, 24, and 26

Claims 2-4, 7, 8, 12, 17-19, 24, and 26 are rejected under 35 U.S.C. §103(a) over *Belknap* in view of *Vilcauskas*. Applicant traverses the rejection.

To establish a prima facie case of obviousness under 35 U.S.C. § 103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the applied reference. Second, there must be a reasonable expectation of success. Finally, the applied reference must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding any other criteria, Applicant respectfully asserts that the rejection does not satisfy the third criterion, as discussed further below.

As shown above, *Belknap* does not teach each and every feature of claims 1, 11, 16, and 23. Claims 2-4, 7, 8, 12, 17-19, 24, and 26 depend from independent claims 1, 11, 16,

and 23, respectively, and therefore inherit the limitations of those independent claims. The Office Action does not rely on *Vilcauskas* to teach or suggest the missing features, nor does *Vilcauskas* teach or suggest the missing features. Thus, the cited combination does not teach or suggest each and every feature of claims 2-4, 7, 8, 12, 17-19, 24, and 26. Accordingly, the withdrawal of the 35 U.S.C. §103(a) rejection of claims 2-4, 7, 8, 12, 17-19, 24, and 26 is respectfully requested.

B. Claims 9 and 14

Claims 9 and 14 are rejected under 35 U.S.C. §103(a) over *Belknap* in further view of *Whiting*. Applicant traverses the rejection.

To establish a prima facie case of obviousness under 35 U.S.C. § 103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the applied reference. Second, there must be a reasonable expectation of success. Finally, the applied reference must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding any other criteria, Applicant respectfully asserts that the rejection does not satisfy the third criterion, as discussed further below.

As shown above, *Belknap* does not teach each and every feature of claims 1 and 11. Claims 9 and 14 depend from independent claims 1 and 11, respectively, and therefore inherit the limitations of those independent claims. The Office Action does not rely on *Whiting* to teach or suggest the missing features, nor does *Whiting* teach or suggest the missing features. Thus, the cited combination does not teach or suggest each and every feature of claims 9 and 14. Accordingly, the withdrawal of the 35 U.S.C. §103(a) rejection of claims 9 and 14 is respectfully requested.

C. Claim 15

Claim 15 rejected under 35 U.S.C. §103(a) over *Belknap* in view of *Vilcauskas* in further view of *Tokue*. Applicant traverses the rejection.

To establish a prima facie case of obviousness under 35 U.S.C. § 103(a), three basic

criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the applied reference. Second, there must be a reasonable expectation of success. Finally, the applied reference must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Without conceding any other criteria, Applicant respectfully asserts that the rejection does not satisfy the third criterion, as discussed further below.

As shown above, *Belknap* does not teach each and every feature of claim 11. Claim 15 depends from independent claim 11, and therefore inherits the limitations of claim 11. The Office Action does not rely on *Vilcauskas* or *Tokue* to teach or suggest the missing features, nor do *Vilcauskas* or *Tokue* teach or suggest the missing features. Thus, the cited combination does not teach or suggest each and every feature of claim 15. Accordingly, the withdrawal of the 35 U.S.C. §103(a) rejection of claim 15 is respectfully requested.

D. Claim 20

Claim 20 rejected under 35 U.S.C. §103(a) over *Belknap* in view of *Vilcauskas* in further view of *Hars*. Applicant traverses the rejection.

To establish a prima facie case of obviousness under 35 U.S.C. § 103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the applied reference. Second, there must be a reasonable expectation of success. Finally, the applied reference must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Without conceding any other criteria, Applicant respectfully asserts that the rejection does not satisfy the third criterion, as discussed further below.

As shown above, *Belknap* does not teach each and every feature of claim 16. Claim 20 depends from independent claim 16, and therefore inherits the limitations of claim 16. The Office Action does not rely on *Vilcauskas* or *Hars* to teach or suggest the missing features, nor do *Vilcauskas* or *Hars* teach or suggest the missing features. Thus, the cited combination does not teach or suggest each and every feature of claim 20. Accordingly, the withdrawal of the 35 U.S.C. §103(a) rejection of claim 20 is respectfully requested.

VIII. Conclusion

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 100202971-1 from which the undersigned is authorized to draw.

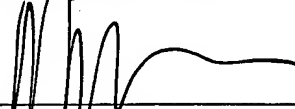
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Date of Deposit: December 13, 2005

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